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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,702	02/13/2001	Raymond F. Cracauer	FORS-06111	4955
23535	7590	02/05/2004	EXAMINER	
MEDLEN & CARROLL, LLP 101 HOWARD STREET SUITE 350 SAN FRANCISCO, CA 94105			FORMAN, BETTY J	
			ART UNIT	PAPER NUMBER
			1634	

DATE MAILED: 02/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/782,702

Applicant(s)

CRACAUER, RAYMOND F.

Examiner

BJ Forman

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached Continuation of Advisory Action.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-25 36-44.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


BJ Forman
Primary Examiner
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Continuation of Advisory Action

Applicant argues that McLuen and Zuckermann do not teach all the limitations of the claims because the references do not teach a receiving hole in a cartridge configured to receive and hold a DNA synthesis column where the cartridge is configured to hold an o-ring such that the o-ring provides a seal between the column and the receiving hole as instantly claimed.

The argument has been considered but is not found persuasive because, as stated in the final office action, the instant claims are drawn to a cartridge, the cartridge is configured to hold synthesis columns and to receive one or more O-rings. The cartridge is not limited to synthesis columns and/or O-rings, but is merely configured so as to hold the columns and O-rings. Furthermore, the instantly claimed cartridge is not limited to being sealed via the o-ring, but is merely configured such that when (if) an o-ring is present the o-ring forms a seal.

McLuen et al teach a cartridge configured to hold DNA synthesis columns wherein the cartridge is further configured to receive the columns forming a seal between the holes and columns (page 12, lines 4-23) which clearly suggests that a seal between the holes and columns are required or desired. McLuen et al do not specifically teach that the cartridge is configured to receive one or more o-rings to provide that desired seal. However, the claims do not recite any structural limitations which define the configuration that differs from that of McLuen.

Applicant appears to be arguing that the recitation "to receive one or more o-rings" limits the structure. However, the recitation does not define or describe any structural component of the configuration but is instead a recitation of intended use.

The courts have stated that claims drawn to an apparatus must be distinguished from the prior art in terms of structure rather than function see *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (see MPEP, 2114). Because the instant cartridge is describe in terms of function rather than structure and because McLuen and Zuckermann teach the claimed structures, the instantly claimed cartridge is not patentably distinguished over the prior art.

Applicant further argues that Zuckermann teaches n o-ring within the DNA column not between the column and cartridge. The argument has been considered but is not found persuasive for the reasons stated above and further because Zuckermann specifically teach an o-ring sealing ring (#150, annular sealing means) positioned between the column (#104) and

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the cartridge (#118). Zuckermann clearly provides motivation for configuring a cartridge for an o-ring sealing means between the column and cartridge as desired by McLuen i.e. the o-ring facilitates sealing between the holes and column (page 11, lines 19-24).

Applicant argues that there is no motivation to combine the teachings of McLuen and Zuckermann because McLuen has not identified a problem with their own "pressure-tight seal". The argument has been considered but is not found persuasive because that fact that McLuen doesn't recognize a problem does not alter the fact that one of ordinary skill at the time the claimed invention was made would recognize such a problem. Furthermore, Zuckermann clearly provide motivation for the claimed configuration i.e. the o-ring facilitates sealing between the holes and column (page 11, lines 19-24).

Applicant reiterates the argument regarding differences between the instant invention and Zuckermann. The argument has been considered but not found persuasive as addressed above.

Furthermore, in contrast to Applicant's assertion, the Office has cited motivation found within the teaching of Zuckermann et al for modifying the teaching of McLuen et al with the teaching of Zuckermann et al i.e. McLuen et al desire a seal between the between the holes and columns (page 12, lines 4-23) and Zuckermann et al. further teach that the o-ring facilitates sealing between the holes and column (page 11, lines 19-24).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (571) 272-0741 until 13 January 2004. The examiner can normally be reached on 6:00 TO 3:30 Monday through Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (703) 308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-0507.

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A handwritten signature in black ink, appearing to be 'BJ Forman', written above the printed name.

BJ Forman, Ph.D.
Primary Examiner
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January 30, 2004